

Remarks

1. Summary of the Office Action

In the final office action mailed August 5, 2008, the Examiner maintained the rejection of claim 20 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In addition, the Examiner maintained rejections of claims 1-6 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2003/0083041 (Kumar), and the Examiner maintained rejections of claims 13-25 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,987,987 (Vacanti).

2. Interview Summary

The undersigned held a brief telephone interview with the Examiner on January 27, 2009, at the Examiner's initiation. The Examiner pointed out that Applicant made a change in the language of claim 4 (as noted above) but did not show the change with strikeout and underlining. Applicant thanks the Examiner for pointing out this oversight. Applicant has now modified the claim listing to show the change to claim 4.

3. Status of the Claims

Pending are claims 1-6 and 13-25, of which claims 1, 4, 13, 16, and 20 are independent and the remainder are dependent.

Applicant notes that there was a typographical error in claim 4 in the response filed April 10, 2008. In that response, line 3 of claim 4 mistakenly included the text "during transmission of the web request" in place of its actual language "during transmission of the web content". (Applicant also inadvertently referred to the wrong "web request" language in the response filed

September 29, 2008; Applicant meant to state that the claim includes the "during transmission of the web content" language but instead inadvertently stated that the claim still includes the "during transmission of the web request" language. Applicant hereby corrects that mistake.)

Following Applicant's response filed September 29, 2008, the Examiner examined claim 4 considering the actual language "during transmission of the web content", as is evident from the final office action at page 7, where the Examiner referred to the correct claim language rather than the "during transmission of the web request" language.

Particularly given that this typographical error apparently did not impact that Examiner's review of the claim, Applicant believes that no formal amendment is necessary to correct this typographical error, since the claim was never actually amended to include the typographical error. (The claim included the proper language in the preceding response, and no amendment markings were provided with respect to that language in the response filed April 10, 2008.) If the Examiner feels a formal amendment is necessary to fix the typographical error, Applicant requests the Examiner to call the undersigned at (312) 913-2141.

4. Response to § 101 Rejection of Claim 20

The Examiner rejected claim 20 as allegedly being directed to non-statutory subject matter, on grounds that the claim allegedly covers embodiments directed to software per se. Applicant submits that this §101 rejection is improper and should be withdrawn, because claim 20 clearly recites subject matter beyond mere software.

Claim 20 recites, *inter alia*, "a network interface for receiving and sending communications on the HTTP communication path, wherein the network interface receives a communication that carries web content and the web content defines a hyperlink that points to

referenced web content". Even if software is involved in implementing functions recited, the physical network interface element clearly makes claim 20 directed to more than mere software.

The Examiner has not established that the recited network interface is merely software or, for that matter, how a network interface could even be mere software. Applicant submits that one of ordinary skill in the art would not reasonably interpret a network interface to be mere software and would thus not read the claim in the manner the Examiner has done.

Because claim 20 recites statutory subject matter, Applicant submits that the § 101 rejection should be withdrawn.

5. Response to § 102 Rejections of Claims 1-6

The Examiner rejected claims 1-6 as being allegedly anticipated by Kumar. Applicant respectfully submits that the rejections of these claims are improper and should be withdrawn, because Kumar does not disclose (expressly or inherently) each and every element of any of these claims.

a. Claims 1-3

Of these claims, claim 1 is independent. Kumar fails to anticipate claim 1, at a minimum because Kumar fails to teach carrying out the computing, engaging, and sending functions *during transmission of the web request within the communication path from the client station to the content server* as claim 1 recited originally and still recites in its amended form. At best, Kumar merely teaches a wireless communication device (client station) itself estimating a cost based on quantity of data to be communicated, and presenting the estimate to a user of the wireless communication device before proceeding with session initiation. Functions carried out at the wireless communication device, according to Kumar, cannot occur during transmission of

the web request within the communication path from the client station to the content server, between the client station and the content server, as recited in claim 1. Further, considering the amended language of claim 1, the functions carried out at the wireless communication device, according to Kumar, cannot occur *between the client station and the content server* as in claim 1.

In the "Response to Arguments" section of the office action, the Examiner disputed this point. However, Applicant submits that a close review shows the Examiner's position is incorrect.

The Examiner noted that Kumar is directed to a cost estimate for the communication session, determined based on quality of service level and quantity of information to be communicated, per Kumar's abstract. The Examiner then noted that Kumar discloses at paragraph 0037 that cost of service information 510 may be provided directly by the networks to a wireless communication device in real time. And the Examiner noted that Kumar teaches at Figure 6 and paragraphs 0045, 0047, and 0051 that the communication session is initiated when the cost estimate is presented to the user and accepted. In light of these pieces of disclosure, the Examiner argued that Kumar clear provides for the claim 1 limitations of "... during transmission of the web request within the communication path between the content server and the client station...", "computing...", "engaging...", and "...sending..."

A review of claim 1 and of Kumar's disclosure shows that this conclusion by the Examiner is erroneous. Kumar is clearly directed to having the wireless device (i.e., the client) estimate the cost of a desired session *before the wireless device sends a request for the content, i.e., before the wireless device actually initiates the session*. It would be impossible in that scenario for the cost to be computed *during* transmission of the web request from the client to the

content server, since the web request has not yet been transmitted at the time the cost is computed by the client. At a bare minimum, Kumar thus does not teach *computing* a size-based cost *during transmission of the web request within the communication path from a client station to a content server, between the client station and the content server.*

Applicant notes that Figure 6 and the accompanying description of Kumar provide for session initiation as a first step 602 of the process. However, it is plainly evident from a reading of Kumar as a whole that the session is not actually initiated by the device until the device receives user approval of the estimated session cost. For instance, see paragraphs 0029 and 0045-0054, particularly the last sentence of paragraph 0048. The best Applicant can guess about the disclosure of step 602 in Kumar is that the step means a user directs the device to initiate a particular session, which then triggers the process of the device performing the cost estimate before actually initiating the session. In any event, there is no disclosure in Kumar that a web request is in transit between the client and the content server when the cost estimate is performed, and so Kumar clearly does not anticipate claim 1.

The Examiner focused on Kumar's disclosure at paragraph 0037 of networks providing cost of service information to the wireless device "in real time" as somehow constituting a disclosure that a size-based cost is computed during transmission of the web request within the communication path from the client to the content server. However, that analysis by the Examiner is not correct. Although Kumar does not explain at paragraph 0037 what "real time" providing of cost of service information means, Kumar defines that concept at paragraphs 0020-0021, where Kumar teaches that networks may provide network capability information (including cost of service information) "in real-time to wireless communication device 102, for

example over a broadcast channel accessible by wireless communication device 102." Yet *broadcasting* such information does not expressly or inherently involve sending the information *during transmission of a web request within the communication path from the client station to the content server.*

Kumar also teaches at paragraph 0037 that the wireless device may request cost of service information from the network and receive the cost of service information in response. However, again, Kumar does not teach that such a request/receive process occurs during transmission of a web request within the communication path from the client station to the content server. Rather, it is clear from a reading of Kumar that the wireless device receives the cost of service information from the network in advance of the device even initiating the session, and so the device clearly has not yet sent a request for the content by the time the session cost is estimated.

Because Kumar does not teach the combination of elements recited by claim 1, Kumar does not anticipate claim 1. Therefore, Applicant submits that claim 1 is allowable. Further, Applicant submits that claims 2-3 are allowable as well for at least the reason that they depend from allowable claim 1.

b. Claims 4-6

Of these claims, claim 4 is independent. Kumar fails to anticipate claim 4, at a minimum because Kumar fails to teach carrying out the computing, engaging, and sending functions *during transmission of the web content within the communication path from the content server to the client station* as claim 4 recited originally and still recites in its amended form. At best, Kumar merely teaches a wireless communication device (client station) itself estimating a cost

based on quantity of data to be communicated, and presenting the estimate to a user of the wireless communication device before proceeding with session initiation. Functions carried out at the wireless communication device, according to Kumar, cannot occur during transmission of the web content within the communication path from the content server to the client station, between the content server and the client station, as recited in claim 4.

Applicant submits that the arguments set forth above regarding claim 1 extend to apply with respect to claim 4. Because Kumar teaches that the wireless device (client) estimates session cost before even initiating the session, it is clear that the wireless device has not sent the content request by the time the wireless device estimates the session cost, and it is therefore clear that the cost estimate is not performed during transmission of the web content from the content server to the client device.

Because Kumar does not teach the combination of elements recited by claim 4, the Examiner has not made out proper case of anticipation of claim 4. Therefore, Applicant submits that claim 4 is allowable. Further, without conceding the Examiner's other assertions, Applicant submits that claims 5-6 are allowable as well for at least the reason that they depend from allowable claim 4.

6. Response to § 102 Rejections of Claims 13-25

The Examiner rejected claims 13-25 as being allegedly anticipated by Vacanti. Applicant respectfully submits that these rejections are improper and should be withdrawn, because Vacanti does not disclose (expressly or inherently) each and every element of any of these claims.

At a minimum, Vacanti does not disclose the combination of elements recited in any of claims 13, 16, and 20, including the function of computing a size-based cost to access the web content and adding an indication of the size-based cost into the web content in conjunction with the hyperlink, such that the indication of the size-based cost will be presented to a user when the web content is presented to the user.

As noted by the Examiner, Vacanti teaches embellishing a hyperlink with an indication of cost to access the referenced web content. However, Vacanti does not teach embellishing the hyperlink with a *size-based cost* to access the referenced web content. Therefore, Vacanti does not anticipate claims 13, 16, and 20.

In the final office action, the Examiner expressed disagreement with this position, by noting that Vacanti further discloses at column 20, lines 51-55, that users pay in advance for quantity of access. However, it is clear from a reading of that section of Vacanti as a whole that the section has nothing to do with determining a size-based cost of given content. At best, that statement in Vacanti may relate to a limitation on the quantity of data being communicated. It does not teach anything about determining a cost based on a given quantity of data (if that is what the Examiner meant), and more specifically it does not disclose the claim function of computing a size-based cost to access the web content. Applicant's claims recite that function. The Vacanti reference does not teach that function.

In the "Response to Argument" section, the Examiner again asserted that Vacanti's disclosure of a user paying in advance for "quantity of access", as well as Vacanti's disclosure of adding cost into web content being delivered to a user, amounts to Applicant's "computing a size-based cost to access the web content" function. However, that conclusion is incorrect. The

cited Vacanti disclosure does not expressly teach computing a size-based cost to access the web content, and such a teaching does not follow necessarily from Vacanti's teachings and is therefore not inherent in Vacanti. It is entirely plausible within the teachings of Vacanti that content cost can be computed on a basis that has nothing to do with the size of the content requested. For instance, content cost can theoretically be computed based on a predefined cost associated with the content file (e.g., based on the usefulness of the content file), such as by reference to a lookup table that lists costs and URLs, as in Vacanti at Figure 13.

Because Vacanti does not expressly or inherently teach the invention as recited in claims 13, 16, and 20, Vacanti does not anticipate any of those claims. Consequently, Applicant submits that claims 13, 16, and 20 are allowable. Further, without conceding the Examiner's other assertions, Applicant submits that claims 14-15, 17-19, and 21-25 are allowable as well for at least the reason that they each depend from one of allowable claims 13, 16, and 20.

7. Conclusion

For the foregoing reasons, Applicant submits that all of the pending claims are in condition for allowance, and Applicant thus respectfully requests favorable reconsideration.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is welcome to call the undersigned at (312) 913-2141.

Respectfully submitted,

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